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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,808	03/03/2000	Yoji Kawamoto	7217/31035	5769
530 7590 07/06/2007 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER NEURAUTER, GEORGE C	
			ART UNIT 2143	PAPER NUMBER
			MAIL DATE 07/06/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/518,808

Applicant(s)

KAWAMOTO ET AL.

Examiner

George C. Neurauter, Jr.

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 2143

**DETAILED ACTION**

Claims 1, 3, and 10 are currently presented and have been examined.

***Response to Arguments***

Applicant's arguments with respect to claims 1, 3, and 10 have been considered but are moot in view of the new ground(s) of rejection.

Claims 1, 3, and 10 recite the conjunction "if" when reciting steps in conjunction with a conditional step. In view of the broadest reasonable interpretation of the claims as required by MPEP 2111, these limitations may be interpreted in the sense that the limitations occur when the condition step occurs, but also introduces the possibility that the conditional step may not occur, thereby rendering the limitation to be not positively recited. Since the claim fails to recite any specific limitations regarding the possibility that the conditional step may not occur, the broadest reasonable interpretation of the claim allows for the possibility wherein no functionality is achieved when the conditional step is not achieved. Therefore, the above interpretation has been considered during the examination of the claims. If the Applicant wishes the limitations to be positively recited, the claims must be amended

Art Unit: 2143

to either recite limitation in the case wherein the conditional step does not occur or remove such a case from consideration.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Art Unit: 2143

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6 697 836 B1 to Kawano et al.

Regarding claim 1, Kawano discloses a network system connecting a plurality of different types of user terminal devices (referred to throughout the reference as "clients") and a network server ("service mediate server") via a known communication system, wherein each user terminal device comprises:

means for retrieving information from a removable memory ("IC card"; column 10, lines 33-38; column 10, lines 33-38) loaded into the terminal device; said removable memory storing user specific information ("service requester information") (column 10, lines 23-42), and

means for transmitting said user specific information and information identifying said terminal device ("client terminal information") as specific information ("service request message") when said removable memory is loaded, wherein said

Art Unit: 2143

information identifying said terminal device includes terminal type attributes and media type attributes corresponding to said terminal device ("condition information" and "service interface"; column 5, lines 38-45; column 9, lines 35-47; see also Figure 3, element 1051c); (column 10, lines 23-42; column 11, lines 27-38) and

said network server comprises:

means for receiving said specific information transmitted by said terminal device used by said user, (column 11, lines 27-38)

means for registering said user specific information and said information identifying said terminal device included in said specific information as registered information, (column 7, lines 21-31; column 8, lines 24-45; column 11, lines 33-38)

means for updating said registered information identifying said terminal device corresponding to said user specific information, (column 7, lines 32-65; column 11, lines 12-19)

means for identifying a latest type of terminal device, based on said updated information by said means for updating, currently being used by said user and for authenticating said user by referring to said registered information, (column 7, lines 32-65; column 11, lines 12-19 and 39-53)

Art Unit: 2143

means for converting ("changing") message information addressed to said authenticated user to a data format compatible with said terminal device based on said terminal type attributes and said media type attributes of said terminal device currently being used by said user (column 2, lines 8-24; column 9, lines 25-47; column 11, line 54-column 12, line 14), and

means for transmitting the converted message information to said terminal device currently being used by said user, wherein, if said user requests message information from the network server and switches from a first terminal device compatible with the first data format to a second terminal device compatible with the second data format before the requested message information is transmitted, the message information is converted from the first data format to the second data format and transmitted to the second terminal device. (Abstract, specifically "The information received by [a server] is processed by the service mediate agent and the processed information is transmitted to [a client]."; column 9, lines 25-47, specifically lines 65-66)

Kawano does not expressly disclose wherein the user specific information includes a group identification for identifying plural users of the user terminal device to form a specific group.

Art Unit: 2143

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the nonfunctional descriptive material with the claimed invention because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the descriptive material does not patentably distinguish the claimed invention.

Regarding claim 3, Kawano discloses the network system according to claim 1.

Kawano does not expressly disclose wherein said means for registering erases said registered information when said removable memory means is extracted from said terminal device, however, Kawano does disclose the use of an memory means as a portable medium as shown above. Kawano also discloses wherein the memory means contains user specific information that



Art Unit: 2143

uniquely identifies a user and contains information exclusive to the user (column 7, lines 21-31; column 8, lines 33-38).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to erase the registered information when the memory means is extracted from the terminal device as disclosed in Kawano. Kawano discloses the memory means as a portable medium, which means that the user uses the memory means as a means to use his or her exclusive information to obtains service from a server for a temporary period of time. One of ordinary skill would recognize this fact and would have considered it obvious that the memory means would eventually be removed when the user no longer required the services of the server. It would logically follow that the registered user's information would no longer be valid at the terminal at which the user used the memory means to obtain service from the server and the user's information would be considered invalid and, at some point in time, erased by an express deletion or by being overwritten by new values.

Therefore, it would have been obvious to achieve the limitations as claimed.

Claim 10 is also rejected since claim 10 recites a network system that contains substantially the same limitations as recited in claims 1 and 3 in combination.

Art Unit: 2143

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

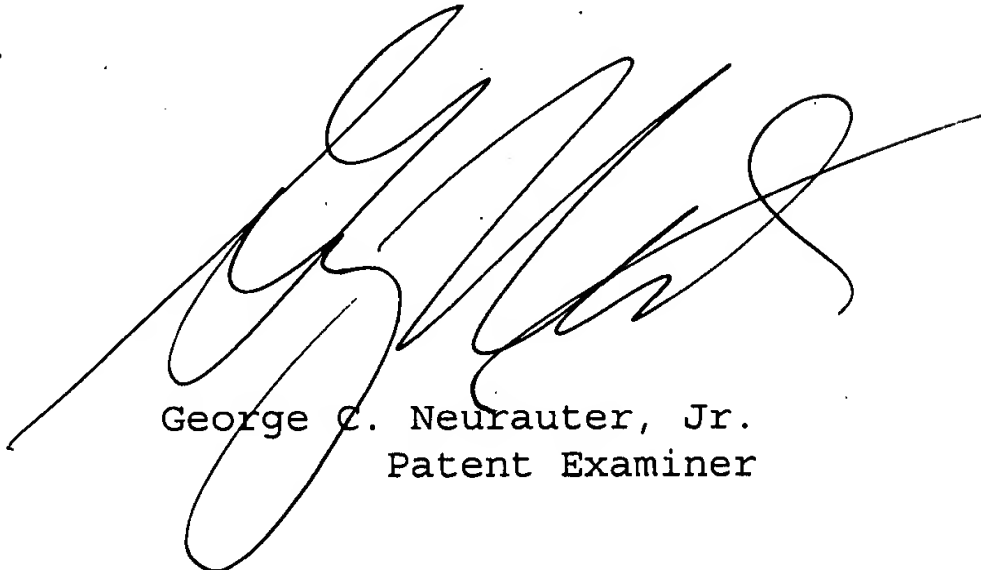
Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is 571-272-3918. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be

Art Unit: 2143

reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



George C. Neurauter, Jr.  
Patent Examiner